



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

50588/21

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

09/858,201

Filed

May 15, 2001

First Named Inventor

Mai-lan Tomsen

Art Unit

2617

Examiner

Jamieson W. Fish

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒ attorney or agent of record.  
Registration number 43,548☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

Kory D. Christensen

Typed or printed name

801-578-6993

Telephone number

4/26/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

1. Claim 1 recites “replacing the first trigger with a second trigger according to pre-selected customer preferences.” This allows a cable operator to provide different triggers to different customers based on the customers’ preferences. For example, some customers may desire to receive only certain types of interactive advertisements, e.g., allow coupons but block all other forms of advertisements. The preferences are communicated to the cable operator, who may then use the preferences to block and/or replace triggers on a customer-by-customer basis. See specification at page 18.

As argued in Applicant's response dated October 26, 2005 (“Response”), there is absolutely no teaching or suggestion in Reynolds of relying on customer preferences to decide whether to substitute enhanced content. In Reynolds, the decision rests entirely with the cable operator. There is no hint or suggestion of communicating customer preferences to the cable operator. Hence, there is no disclosed mechanism in Reynolds for allowing substitution based on customer preferences.

The Final Office Action (“FOA”) nevertheless asserts that Reynolds meets this limitation. See FOA at page 2. However, in making this rejection, the Examiner impermissibly relies on the Applicant’s own teachings. Specifically, the Examiner states that the “applicant’s specification gives an example of ‘local weather’ as customer preference (See Specification Page 22 and Remarks Page 9 paragraph 1).” The Examiner then proceeds to argue that local advertisements (as in Reynolds) are analogous to local weather.

This example of hindsight reconstruction is impermissible because it takes the idea of allowing the customer to decide which triggers to receive from Applicant’s disclosure. The bare concepts of “local weather” and “local advertisements” might indeed be similar, but that is not the claimed invention. Reynolds does not disclose or suggest allowing the customer to decide whether to receive local weather versus to national weather, but relies solely on the cable operator for this determination.

To establish “anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.” MPEP 706.02(a). Because the limitation of “replacing the first trigger with a second trigger according to pre-selected customer preferences” was taken from Applicant’s disclosure instead of the prior art, the rejection is improper and should be withdrawn.

2. Claim 18 recites a method for blocking access to selected enhanced content by “removing the first trigger from the television broadcast; and sending the television broadcast [after removal of the first trigger] to an interactive television system of a customer without replacing the first trigger with a second trigger.” Thus, the claimed invention strips the trigger from the broadcast and sends the stripped broadcast to the customer, effectively blocking access to the enhanced content associated with the first trigger.

The FOA asserts that Reynolds teaches blocking of enhanced content associated with the second trigger (*i.e.*, the local meta data) because substitution of local meta data is sometimes not permissible. FOA at page 3. However, substitution and blocking are two completely different concepts. As explained in paragraph [0041] of Reynolds, if substitution is permissible, the local meta data is retrieved from the local meta data center and forwarded to the inserter, where it is inserted into the broadcast. If substitution is not permissible, as described in paragraph [0042] of Reynolds, “the *originally extracted meta data* component 114 is forwarded, at 212, to the inserter 136,” where it is inserted back into the broadcast. Emphasis added. In other words, Reynolds either substitutes a second trigger for a first trigger (local for national content) or it allows the first trigger (national content) to pass through. Reynolds does not teach or suggest “blocking” national content without substitution. Moreover, it makes no sense to refer to “blocking” the local content, as is done in the FOA, because it was never part of the broadcast.

The Office’s argument completely fails to address the claimed limitations of removing the first trigger from the television broadcast and sending that television broadcast (from which the first trigger was removed) to an interactive television system of a customer. The FOA refers to inserting “generic meta data” into the stream when it is not permissible to substitute local meta data. However, in Reynolds, the “generic meta data” is simply the “national advertising campaign” (see Reynolds paragraph [0027]). Reynolds does not teach removal (blocking) of the national advertising campaign without substituting local content in its place. Hence, Reynolds does not teach every aspect of the claimed invention, and the anticipation rejection is improper.

3. Claim 36 recites that the intercepting and removing steps are only performed for selected customers. As argued in the Response, the references do not disclose or suggest, alone or in combination, the selective blocking of triggers for certain customers and not for others.

The FOA argues that “Reynolds teaches wherein the intercepting and removing steps are only performed for selected customers (See Paragraph 28 *Meta data intercepting and removing can be at any distribution point*).” FOA at page 5 (emphasis added). Applicant fails to see how the location of the meta data substitution system has anything to do with selective blocking of triggers for certain customers. Whether the meta data substitution system is located at “a regional television network, a local television affiliate, a local cable headend, or an internet service provider” (Reynolds paragraph [0028]), there is no teaching or suggestion in Reynolds that only certain customers serviced by a regional television network will have triggers intercepted and removed. This element is completely absent from the cited references. Accordingly, the rejection is clearly erroneous and should be withdrawn.

4. Claims 39 recites blocking all triggers of a particular type, such as all interactive commercials (claim 40). As argued in Applicant’s Response, neither of the references discloses or suggests blocking triggers, as opposed to substituting triggers or allowing content to simply pass through (see Reynolds paragraphs [0041] and [0042]). Neither of the references blocks all triggers of a particular type, as recited in claim 39. For instance, neither of the references blocks all interactive commercials, as recited in claim 40.

With regard to blocking triggers of a particular type (claim 39), the FOA refers to paragraph [0041] of Reynolds. FOA at page 6. However, Reynolds merely states that meta data substitution may be permitted or not. If not, the original meta data is reinserted or simply passed through the system. Reynolds does not refer to blocking a particular “type” of trigger or anything analogous thereto. Accordingly, the reference does not teach every aspect of claims 39 and 40, and the anticipation rejection should be withdrawn.

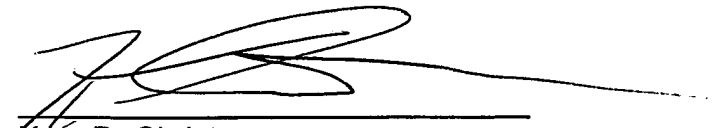
5. Claim 42 recites creating a second trigger by appending a second link to a first link and replacing the first trigger with the second trigger within the television

broadcast. Claim 43 recites adding a mechanism to the second trigger for providing a customer with a choice between the first link and the second link.

As argued in Applicant's Response, neither of the cited references discloses or suggests "appending" a second link to a first link to create a second trigger. Blackketter's "enhancement triggers" include "two or more information resources" from the outset. See Blackketter's Abstract. There is no teaching or suggestion of "appending" anything to Blackketter's triggers. Likewise, Reynolds does not disclose or suggest appending links (or anything else) to a trigger. Reynolds mentions substitution of national content with local content, but certainly does not disclose or suggest the claimed step of "creating a second trigger by appending a second link to [a] first link." Substituting local content for national content could hardly be referred to as "appending" the local content to the national content. The two are mutually exclusive. Because neither reference suggests substituting a first trigger with a second trigger in which a second link has been appended to a first link, Applicant respectfully submits that a prima facie case of obviousness has not been established.

Blackketter also fails to disclose or suggest adding a mechanism to a trigger to allow a user to choose between the original and the appended link, thereby creating a choice where none previously existed, as in claim 43. Indeed, there is no need to add such a mechanism to Blackketter because his enhancement triggers already include two or more information resources, as discussed above. No teaching or suggestion for this limitation is provided in Reynolds because Reynolds also does not append triggers. Accordingly, a prima facie case of obviousness has not been established.

Respectfully submitted,



Kory D. Christensen  
Reg. No. 43, 548

STOEL RIVES LLP  
201 S Main Street, Suite 1100  
Salt Lake City, UT 84111-4904  
Telephone: (801) 328-3131  
Facsimile: (801) 578-6999